

II. Information Disclosure Statement

Applicants filed an Information Disclosure Statement on June 19, 2001.

On the copy of the PTO Form 1449 returned to Applicants with the present Office Action, the Examiner did not initial the citation of Revlon Colorstay®'s product label. Accordingly, Applicants respectfully request that the Examiner consider this document and sign off on this document as being considered.

III. Rejections under 35 U.S.C. § 112, Second Paragraph

In order to meet the requirements of 35 U.S.C. § 112, second paragraph, the claims must define the patentable subject matter with a reasonable degree of particularity and precision. M.P.E.P. § 2173.02 (emphasis in original). The Federal Circuit has decided that the definiteness of the claim language must be analyzed, not in a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.* The definiteness of a claim is an objective inquiry which evaluates whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. See *e.g.*, M.P.E.P. § 2171.

Claims 16, 31, 50, 65, 85, 99, and 118

Claims 16, 31, 50, 65, 85, 99, and 118 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention for the reasons set forth on pages 2 and 3 of the present Office Action.

As an initial matter, Applicants note the Examiner's assertion of her position "that the claims are drawn to compositions which are useful as mascara, lip[compositions], and make-up." See page 3 of the present Office Action. Although the compositions of the present invention may be useful in such forms, the instant claims are not limited to any particular form. Thus, for example, any composition comprising the at least one polymethylsilsequioxane film former and the at least one film former according to the present invention wherein the at least one polymethylsilsequioxane film former is present in an amount effective to provide at least one property chosen from long wear and transfer resistance to the composition is within the scope of the present claims.

The Examiner has maintained this rejection despite Applicants' showing that the term "biological materials" is a term of art which refers to "[m]edical products produced from living organisms or their products." See page 140 of Hawley's Condensed Chemical Dictionary, Thirteenth Edition, defining

"biologicals" (copy previously provided). In the present Office Action, the Examiner refers to "compounds like antigens, antitoxins, serums, and vaccines."

See page 3 of the present Office Action. However, Applicants note that the examples listed in Hawley's Condensed Chemical Dictionary's definition of biologicals, i.e., antigens, antitoxins, serums, and vaccines, are merely exemplary and not definitional.

Further, the Examiner states that "the purpose of these biological materials in the cosmetic compositions" is not clear to her. See page 3 of the present Office Action. However, it is well known that biological materials are added to cosmetic products to achieve specific formulation features. See e.g., International Cosmetic Ingredient Dictionary and Handbook ("CTFA") (found at www.pharmacos.eudra.org/F3/inci/incifunc.htm - attached herewith). For example, collagen, a known biological material, "is used in the cosmetic industry as the basis for face creams, lotions, and hair preparations." See page 288 of Hawley's Condensed Chemical Dictionary, Thirteenth Edition, defining collagen (attached herewith).

Accordingly, when the definiteness of the rejected claim language is properly analyzed, not in a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the

time the invention was made, the expression "biological materials" defines the patentable subject matter with the requisite reasonable degree of particularity and precision. Accordingly, Applicants request that this rejection be withdrawn.

Claims 16, 31, 50, 65, 85, 99, and 118

Claims 16, 31, 50, 65, 85, 99, and 118 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that the expression "derivatives of any of the foregoing" is without metes and bounds. See pages 2-3 of the present Office Action. Applicants respectfully disagree and traverse this rejection.

The Examiner maintained this rejection despite Applicants' showing that a "derivative" is "[a] compound derived or obtained from another and containing the essential elements of the parent substance." Specifically, the Examiner concludes that "the metes and bounds of this term cannot be determined from the disclosure" because "there are many functional groups in any given molecule and once the compound is derivatized the functional property changes" and See page 3 of the present Office Action. However, there is no functional requirement for the at least one additional ingredient recited in the rejected claims.

Accordingly, the fact that derivatization may change a functional property of the

at least one additional ingredient is irrelevant. Moreover, breadth is not indefiniteness under § 112, second paragraph. M.P.E.P. § 2173.04.

Applicants maintain that one of ordinary skill in the art would recognize that the at least one additional ingredient may be chosen from the recited ingredients and any compound produced or obtained from the recited ingredients which contain the essential elements of the recited ingredients.

Accordingly, when the definiteness of the rejected claim language is properly analyzed, not in a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made, the expression "and derivatives of any of the foregoing" defines the patentable subject matter with the requisite reasonable degree of particularity and precision. Accordingly, Applicants request that this rejection be withdrawn.

IV. Rejection Under 35 U.S.C. § 103(a)

Claims 1-66, 70-101, and 104-118 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of J.P. Abstract 5025019 ("*JP '019*"), U.S. Patent No. 5,959,009 ("*US '009*"), and U.S. Patent No. 5,756,082 ("*US '082*") for

the reasons set forth on pages 4-5 of present Office Action. Applicants disagree and respectfully traverse this rejection.

Two of the basic criteria an Examiner must demonstrate in order to establish a prima facie case of obviousness are (1) that the reference (or references when combined) teach or suggest all the claim limitations, and (2) that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143. Neither of these two criteria has been satisfied with respect to the combination of references proposed by the Examiner.

When combined in the manner proposed by the Examiner, the cited references fail to teach or suggest all the claim limitations, such as, for example, the presently claimed at least one polymethylsilsesquioxane film former. While the Examiner admits that *US '009* and *US '082* "do not teach component 1," i.e., polymethylsilsesquioxane, she asserts that *JP '019* "teaches polymethyl silsesquioxanes in cosmetic compositions." See page 4 of the present Office Action.

JP '019 discloses a cosmetic powder consisting of "a spherical polymer powder surface-treated with a surfactant(s) having perfluoroalkyl" groups, wherein "[t]he polymer powder is e.g. one or a mixt[ure] of polymethyl

silsesquioxane, nylon, polymethyl methacrylate...." See *JP '019*. However, as discussed in paragraph 041 at page 11 of the present specification:

The at least one polymethylsilsesquioxane of the present invention is necessarily a film former. Not all polymethylsilsesquioxanes are film formers, and thus, not all polymethylsilsesquioxanes are encompassed within the scope of the present invention. For example, the highly polymerized polymethylsilsesquioxanes (T Resins), such as TospearlTM from Toshiba and KMP590 from Shin-Etsu, are **highly insoluble and therefore are not film formers** according to the present invention.

There is no evidence of record that the polymethyl silsesquioxanes of *JP '019* are film formers. In contrast, this Abstract states that the cosmetic "**powder**, [has]...**high water and oil repellency**." See *JP '019* (emphasis added).

Accordingly, the cited references at least fail to teach or suggest the presently claimed at least one polymethylsilsesquioxane film former. For at least this reason, Applicants respectfully request withdrawal of this rejection.

With respect to the second requirement, that is, of some suggestion or motivation to modify or combine reference teachings, the Examiner has failed to demonstrate such a suggestion or motivation. The Examiner asserts that "[t]he motivation to use the polymethyl silsesquioxanes in the compositions [of *US '009* or *US '082*] stems from the teachings of the [*JP '019*] abstract that this [polymethyl silsesquioxane] polymer used in the cosmetic material has high resistance to water." See page 5 of the present Office Action. However, the

cosmetic powder of *JP '019* has "**high water and oil repellency.**" See *JP '019* (emphasis added).

In contrast, the compositions of *US '009* expressly require a volatile **oil**. See e.g., Abstract. Similarly, the compositions of *US '082* expressly require a **volatile silicone** and a gel composition comprising a hydrocarbon **oil**. Accordingly, one of ordinary skill in the art would not be motivated to combine the cosmetic powder of *JP '019* having high oil repellency with the compositions of *US '009* or *US '082*, which both expressly require at least one oil.

In light of the foregoing, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, and thus, request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

V. Allowable Subject Matter

Claims 67-69 and 102-103 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for her indication of allowability but choose not to rewrite these claims at this time.

VI. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of the pending claims, reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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in water, alcohol, and chloroform. Solutions are levorotatory.

Derivation: From *Colchicum autumnale* by extraction and subsequent crystallization. Has been synthesized.

Grade: Technical, USP.

Hazard: As little as 20 mg may be fatal if ingested.

Use: To induce chromosome doubling in plants; phytopathology.

colcothar. Red ferric oxide produced by heating ferrous sulfate in air.

Use: Pigment; abrasive in polishing glass.

cold flow. The permanent deformation of a material that occurs as a result of prolonged compression or extension at or near room temperature. Some plastics and vulcanized rubber exhibit this behavior. In metals it is known as creep.

cold light. See bioluminescence.

cold rubber. Synthetic rubber produced by polymerization at relatively low temperature, specifically SBR or butadiene-styrene elastomers produced by polymerization at approximately 4.4C rather than the usual temperature of approximately 49C. A special catalyst system is required.

cold-short. See short.

colemanite. ($\text{Ca}_2\text{B}_6\text{O}_{11} \cdot 5\text{H}_2\text{O}$). The ore of calcium borate. Used to replace boric acid in the manufacture of glass fibers. Mined in Turkey, it began to be imported into the U.S. in large volume in 1965 and is competitive with domestically produced B_2O_3 .

Properties: D 2.26–2.48.

Derivation: From kernite.

colestipol. An anion exchange resin, highly cross-linked and insoluble. A specific formula has not been ascertained. Said to be a copolymer of diethylene triamine and chloroepoxypropane. It is used as a cholesterol-sequestering agent in medicine.

colistin. $\text{C}_{45}\text{H}_{85}\text{N}_{13}\text{O}_{10}$. Antibiotic produced by a soil microorganism. Probably identical to polymyxin E and closely related chemically to polymyxin B since it is a polypeptide composed of amino acids and a fatty acid.

See polymyxin.

collagen. A fibrous protein constituting most of the white fiber in the connective tissues of animals and humans, especially in the skin, muscles, and tendons. The most abundant protein in the animal kingdom, it is rich in proline and hydroxyproline. The molecule is analogous to a three-strand rope, in which each strand is a polypeptide chain. It has a molecular weight of approximately 100,000. Glue

made from the collagen of animal hides and skins is still widely used as an adhesive. So-called "soluble" collagen is that first formed in the skin; upon aging it becomes increasingly cross-linked and less hygroscopic. Soluble collagen is used in the cosmetic industry as the basis for face creams, lotions, and hair preparations. Special forms of collagen have been developed for dialysis membranes. Microcrystalline collagen is used in prosthetic devices and other medical and surgical applications. Regenerated collagen, used in sausage casings, is made by neutralizing with acid collagen that has been purified by alkaline treatment. Collagen is converted to gelatin by boiling water, which causes hydrolytic cleavage of the protein to a mixture of degradation products.

See gelatin.

collection trap. Cooled container that collects gas-chromatographic eluant, preserving the eluant for the compound-identification step.

2,4,6-collidine. (2,4,6-trimethylpyridine). $(\text{CH}_3)_3\text{C}_5\text{H}_2\text{N}$.

Properties: Colorless liquid. Bp 170.4C, fp -44.5C, d 0.913 (20/20C), refr index 1.4981 (20C). Soluble in alcohol; slightly soluble in water. Combustible.

Grade: Technical, (97.5% purity).

Use: Chemical intermediate, dehydrohalogenating agent.

colligative property. A property independent of the chemical nature of the molecules of a substance, resulting only from the number of molecules present.

collodion. A solution of pyroxylin (nitrocellulose) in ether and alcohol. USP specifications are pyroxylin 40 g, ether 750 ml, and alcohol 250 ml.

Properties: Pale-yellow, syrupy liquid; odor of ether. Immiscible with water; flash p approximately 0F (-17.7C).

Grade: Technical, USP.

Hazard: Flammable, dangerous fire risk.

Use: Cements, coating wounds and abrasions, solvent for drugs, corn removers, process engraving, lithography, photography.

See nitrocellulose.

colloidal solution. A system intermediate between a true solution and a suspension. A dispersion where the particle size is between 1 and 100 nm. Colloids have little or no tendency to dialyze and small or no freezing-point depression.

colloid, association. See association.

colloid chemistry. A subdivision of physical chemistry comprising the study of phenomena characteristic of matter when one or more of its dimensions lie in the range between 1 millimicron

biological additives

Substances derived from biological origin which are added to cosmetic products to achieve specific formulation features